

Remarks/Arguments:

This Amendment is being filed together with a Request For Continued Examination. It is respectfully requested that this Amendment be entered and the claims be reconsidered in accordance with the remarks set forth herein.

Claims 1, 10 and 11 stand rejected under 35 U.S.C. §103(a) as obvious based on U.S. Patent No. 6,984,245 (McGahan et al.) in view of U.S. Patent No. 5,192,327 (Brantigan). Claims 13 and 22 stand rejected under 35 U.S.C. §103 as obvious based on McGahan et al. in view of U.S. Published Application No. US2003/0069640 (Ferreira et al.). Applicants respectfully traverse these rejections.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2143.

Independent claim 1 recites a spinal bone implant, comprising: "a first insertion tool pin hole on a first flat sidewall portion; and a second insertion toll pin hole on a second flat sidewall portion at an angle of about 30 degrees to said first insertion pin hole, wherein a first inside pin surface of said first insertion pin hole and a second inside pin surface of said second insertion pin are smooth, non-threaded surfaces, the first and second pin holes adapted for simultaneous engagement by first and second insertion tool pins."

Brantigan is cited as showing "a threaded hole and corresponding threaded tool can be replaced by a pair of unthreaded holes and a tool with pins." As shown in Figure 14 of Brantigan and explained at column 7, lines 1-3, "[a]lternately, the plug 11, as illustrated in FIG. 14 may have a pair of side-by-side holes 13a receiving the tine end 74 of a modified tool 75." (emphasis added). The holes of Brantigan are side-by-side on the same surface, thereby allowing the fixed tines of the modified tool to engage the holes. There would be no reasonable basis to modify the holes of McGahan to be non-threaded as the modified tool 75 of Brantigan would not be able to engage both of the holes. Additionally, with the holes on the same surface of Brantigan, an axial force on the tool may easily dislodge the implant from the tool. None of

the cited references, alone or in combination, recognize the ability and advantages of having two non-threaded holes angled relative to one another to provide a secure engagement with a relatively easier release of the implant.

The office action fails to provide a reasonable basis for combining the references. The suggested modification would be inoperable based on the teachings of the references. Furthermore, assuming for arguments sake that the references could be reasonably combined, the cited references fail to teach or suggest each limitation of the claimed invention. It is respectfully submitted that independent claim 1 is in condition for allowance. Claims 10 and 11 each depend from claim 1 and are therefore allowable for at least the reasons set forth above. Similarly, withdrawn claims 2, 4-9 and 12 should be allowed as being dependent on allowable generic claim 1.

Independent claim 13 recites a "spinal implant, comprising: a bone implant body including a superior end face; an inferior end face; an outer sidewall extending between said superior end face and said inferior end face, said outer sidewall including at least two flat sidewall portions; and concentric cuts on said superior end face and said inferior end face, said outer sidewall maintaining a natural shape of bone between opposed edges of the first and second flat sidewall portions."

McGahan et al. references Figure 4 thereof and explains at column 4, lines 36-38, that "outline 36 represents a typical outline of an allograft ring suitable for use to form an implant according to the present invention." McGahan et al. further explains at column 5, lines 13-15 that "the multi-faceted implant provides three pairs of substantially parallel side walls." It is clear from Figure 4 that walls 20, 24, 26, 28 and 30, which extend between the opposed edges of flat portions 18 and 22 are machined to be flat surfaces well within the outline 36 of the allograft ring. McGahan et al. specifically teaches that the implant is machined away from a natural shape of bone between opposed edges of the first and second flat sidewall portions.

The cited references, alone or in any reasonable combination, fail to teach or suggest each limitation of the claimed invention. It is respectfully submitted that independent claim 13 is in condition for allowance. Withdrawn claims 14-21 and 23 should be allowed as being dependent on allowable generic claim 13.

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It is respectfully submitted that each of the pending claims is in condition for allowance. Early reconsideration and allowance of each of the pending claims are respectfully requested.

If the Examiner believes an interview, either personal or telephonic, will advance the prosecution of this matter, the Examiner is invited to contact the undersigned to arrange the same.

Respectfully submitted,



Jonathan H. Spadt, Reg. No. 45,122
Glenn M. Massina, Reg. No. 40,081
Attorneys for Applicants

JHS/GMM/

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☒ P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700

☐ P.O. Box 1596
Wilmington, DE 19899
(302) 778-2500

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